

REMARKS/ARGUMENTS

Claims 1-3, 7-12, 14-17, 20-25 and 28-34 remain under consideration in this application. Claims 4-6, 18-19 and 26-27 have been cancelled. Claim 13 has been withdrawn. Claims 1, 2, 10, and 14-16 have been amended. New Claims 28-34 have been added. Insofar as the total number of pending claims has not increased, no additional fee is due.

The Examiner has issued a restriction requirement requiring the applicant to elect an invention from Group I, II or III as delineated in the office action. The applicant has elected the Group I claims, with traverse with respect to non-elected Group II and without traverse with respect to non-elected Group III. Accordingly, the claim of Group II, namely, Claim 13, has been withdrawn from further consideration, and applicant has cancelled the claims of Group III, namely Claims 26-27, without prejudice, while reserving the right to pursue such claims in a divisional and/or continuation application.

The Examiner has rejected Claims 1-2, 4-9, 11, 14, 16 and 18-25 under 35 U.S.C. § 103(a) as being patentable over Collins in view of Mazureck. Independent claims 1 and 14 have been amended to require a layer of finish. Collins in no way discloses or suggests a layer of finish as required by amended Claims 1 and 14. The water-insoluble protective layer disclosed in Collins is provided solely for purposes of protection, and nothing in Collins suggests that such layer would serve as a finish, i.e. would modify the appearance of the decal. Even if one or more of the compounds disclosed in Collins for use in the water-insoluble protective layer would inherently serve as a finish, there is no motivation to select such compounds from the group disclosed by Collins. Mazureck similarly provides no disclosure or suggestion of the claimed finish. As such, applicant submits that amended claims 1 and 14 are patentable over Collins in view of Mazureck.

Because pending dependent claims 2, 7-9, 11, 16 and 20-22 contain all of the limitation of independent claim 1 or 14, such claims are likewise patentable over Collins in view of

Mazureck. Furthermore, there is no suggestion in Collins or Mazureck to produce a decal having a layer of finish in addition to the water-insoluble protective layer, as required by Claims 2 and 16, and there is no suggestion in either reference to combine a finish and a water-insoluble compound in a single layer, as claimed in Claims 30 and 31. In addition, there is no suggestion that the water-insoluble layer of Collins produce a matte finish or contain color or texture, as claimed in new Claims 32-34. Finally, there is nothing in Collins or Mazureck to suggest a decorative section as required by claim 11. For the foregoing reasons, applicant respectfully submits that dependent claims 2, 7-9, 11, 16 and 20-22, and new claims 30-34 are patentable over Collins in view of Mazureck.

With respect to Claims 7-9 and 20-25, there is nothing in Collins or Mazureck to disclose a barrier layer positioned between first and second adhesive sub-layers. The release liners of Mazureck, like the backing sheets (30a and b) of the present invention, are positioned on either side of the adhesive layer and are removed prior to applying the decal to a substrate. In contrast, the barrier layer (32) of the present invention is contained within the adhesive (28), sandwiched between two adhesive sub-layers (34a and b), which are in turn sandwiched between the backing sheets (30a and b), as best illustrated in Figure 2B. After application of the decal of the present invention to the substrate, the barrier layer of the present invention remains positioned between the first and second adhesive sub-layers. There is nothing in Mazureck to suggest such a barrier layer. The fact that the backing disclosed in Mazureck may be opaque, is therefore irrelevant, insofar as there is absolutely no suggestion in Collins or Mazureck to place such a backing sandwiched between adhesive sub-layers. In view of the foregoing, applicant respectfully submits that Claims 7-9 and 20-25 are patentable over Collins in view of Mazureck and respectfully requests removal of the rejection under § 103(a).

Examiner has rejected Claims 14, 16 and 18-22 under 35 U.S.C. § 102(e) as being anticipated by Collins. The Examiner's arguments with respect to pending claims 14 and 16, and 20-22 which depend therefrom, are moot in view of the amendments to Claim 14. In addition,

Claims 14, 16 and 20-22 are not obvious over Collins or Collins in view of Mazureck for the reasons discussed above.

The Examiner has rejected Claims 3, 10, 15 and 17 under 35 U.S.C. § 103(a) over Collins in view of Mazureck. Applicant submits that the Examiner's arguments are moot in view of the amendments to Claims 1 and 14, off of which the claims in question depend.

Finally, the Examiner has rejected Claims 10 and 15 under 35 U.S.C. § 112, first paragraph. Applicant has amended the claims to indicate that the unit of measurement is inches. This is supported by the specifications in Paragraphs 0019, 0035, and 0039. Removal of the rejection under 35 U.S.C. § 112, first paragraph, is therefore respectfully requested.

In view of the foregoing amendments and remarks, it is respectfully submitted that the claims are now in condition for allowance and eventual issuance. Such action is respectfully requested. Should the Examiner have any further questions or comments which need be addressed in order to obtain allowance, he is invited to contact the undersigned attorney at the number listed below.

Acknowledgement of receipt is respectfully requested.

Respectfully submitted,

By: 

Andrea F. Sellers, Reg. No. 44,102
STINSON MORRISON HECKER LLP
1201 Walnut, Suite 2800
Kansas City, MO 64106-2150
Telephone: (816) 842-8600
Facsimile: (816) 691-3495
Attorney for Applicant